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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,564	02/25/2002	Tetsu Takahashi	1614.1218	8623
21171	7590	07/11/2007	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			HASAN, SYED Y	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/080,564	TAKAHASHI, TETSU	
	Examiner	Art Unit	
	Syed Y. Hasan	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 April 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 - 22 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 - 4, 8 - 15 and 19 - 22 is/are rejected.
- 7) Claim(s) 5 - 7 and 16 - 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 04/09/2007 have been fully considered but they are not persuasive.

In re page 11 applicant argues that in claim 1 and 12 that the configuration of the present invention is clearly different from that of Hatanaka et al.

In response examiner respectfully disagrees. The invention of Hatanaka et al taken as a whole reads on the applicants invention. Regarding claim 1, a control part (fig 1, 18, col 2, lines 43 – 44, a packet control circuit) setting a predetermined bit rate (fig 9, col 8, lines 37 – 44, SP, EP and LP modes) to be applied by said coding/decoding part in case the given signal is output after being coded and decoded by said coding/decoding part without storage (figure 10, col 8, lines 52 – 67, illustrate coding/decoding without storage and utilizing the predetermined bit rate) thereof in said recording medium. The same argument applies to claim 12.

Hence claims 1 and 12 stay rejected.

In re page 11 again applicant argues regarding claims 4 and 15, that Hatanaka et al. discloses switching between digital recording and analog recording , whereas the present invention, a bit rate is controlled.

In response examiner disagrees. Hatanaka et al, discloses in (col 8, lines 37 – 52, that the bit rate is controlled). All the three modes dictate what bit rate recording will be performed. The limitation "control part automatically setting a predetermined rate" is being met by the invention of Hatanaka et al. There is no mention of the mode required

to meet this limitation. Hence the invention of Hatanaka et al overcomes this limitation.

Hence claims 4 and 15 stay rejected.

Therefore claims 1 – 4, 8 – 9, 12 – 15 and 19 – 20 stay rejected.

In re page 11, again the applicant argues regarding claims 8 and 14 that

Hatanaka et al. discloses, Selecting one of analog playback and digital playback and in contrast, according to the present invention, control is made whether the image signal is accessible.

In response examiner respectfully disagrees. Hatanaka et al discloses (figure 9, col 7, lines 36 – 40 illustrate automatic recording. Furthermore fig 9, col 7, lines 51 – 59 illustrate recording the image signal. Also col 7, lines 61 – 65 illustrate playback of the same recording material.)

Hence claims 8 and 19 stay rejected.

In re page 12 applicant argues with respect to "LACK OF PRIMA FACIE OBVIOUSNESS OF THE COMBINATION OF REFERENCES RELIED UPON".
Applicant states that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck,

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947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 -§ 2143.03 for decisions pertinent to each of these criteria.

In response, examiner disagrees. Regarding claims 10 and 21 the teaching for the “control part causes the image signal to be recorded into a file, which a user cannot access” is being provided by Yoshida et al (US 2003/0120942). Yoshida et al teaches “automatically starts the recording operation” and “a system region that a user cannot access”. This teaching in combination with the disclosure of Hatanaka et al (US 6397000) provide the reference to arrive at the claimed invention. The motivation to combine these teachings is generally available to one of ordinary skill in the art at the time of the invention. Here the combination teaches all the claimed limitation with a reasonable expectation of success.

Not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references discloses. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F. 2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to

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complement that which is disclosed therein. In re Bode, 550 F.2d 656, 193 USPQ 12 (CCPA 1977).

The same arguments apply to claims 11 and 22.

Hence claims 10 – 11 and 21 – 22 stay rejected.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 4, 8 - 9, 12 – 15 and 19 - 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hatanaka et al (US 6397000)

Regarding claims 1 and 12, Hatanaka et al discloses, an image recording apparatus comprising:

a coding/decoding (fig 1, 10, col 2, line 39, MPEG Decoder)/decoding (fig 1, 11, col 2, line 40, NTSC Encoder) part performing coding and decoding a given signal in one of a plurality of coding/decoding modes of different bit rates (fig 9, col 8, lines 37 – 44, SP, EP and LP modes)

a recording medium (fig 1, 2, col 2, lines 34 – 35, a recording/playback device) coupled with said coding/decoding part (fig 1, 10 and 11 from above); and

a control part (fig 1, 18, col 2, lines 43 – 44, a packet control circuit) setting a

predetermined bit rate (fig 9, col 8, lines 37 – 44, SP, EP and LP modes) to be applied by said coding/decoding part in case the given signal is output after being coded and decoded by said coding/decoding part without storage (figure 10, col 8, lines 52 – 67, illustrate coding/decoding without storage and utilizing the predetermined bit rate) thereof in said recording medium.

Regarding claims 2 and 13, Hatanaka et al discloses the image recording apparatus, wherein the predetermined bit rate is that on such a mode of the plurality of coding/decoding modes as to provide the highest image quality (fig 9, col 8, line 40 – 41, triple mode(EP mode))

Regarding claims 3 and 14, Hatanaka et al discloses the image recording apparatus, wherein the predetermined bit rate is further higher than that on such a mode of the plurality of coding/decoding modes as to provide the highest image quality (fig 9, col 8, line 40 –41, triple mode(EP mode))

Regarding claims 4 and 15, Hatanaka et al discloses an image recording apparatus comprising:

a coding/decoding part performing coding and decoding a given signal in one of a plurality of coding/decoding modes of different bit rates (rejected based on claim 1 above)

a recording medium coupled with said coding/decoding part (rejected based on claim 1 above) and

a control part automatically setting a predetermined bit rate to be applied by said coding/decoding part according to a predetermined parameter concerning recording of

the given signal to be recorded into said recording medium (fig 9, col 8, lines 44 – 51, system automatically detects the setting and col 8, lines 37 – 52, that the bit rate is controlled)

Regarding claims 8 and 19, Hatanaka et al discloses an image recording apparatus comprising:

a coding/decoding part performing coding and decoding a given signal in one of a plurality of coding/decoding modes of different bit rates (rejected based on claim 1 above)

a recording medium coupled with said coding/decoding part (rejected based on claim 1 above); and

a control part causing an input image signal to be automatically recorded into said recording medium even if no instructions for recording the input image signal is given ((figure 9, col 7, lines 36 – 40 illustrate automatic recording. Furthermore fig 9, col 7, lines 51 – 59 illustrate recording the image signal) and causing the image signal thus recorded into the recording medium to be accessible when predetermined instructions concerning the image signal is given. (col 7, lines 61 – 65 illustrate playback of the same recording material)

Regarding claims 9 and 20, Hatanaka et al discloses the image recording apparatus, wherein said control part does not perform the automatic recording of the image signal when the remaining storage capacity of the recording medium is less than a predetermined value (fig 9, col 8, lines 52 – 58, automatic recording of digital signal is prohibited)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 10 – 11 and 21 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatanaka et al (US 6397000) and further in view of Yoshida et al (US 2003/0120942).

Regarding claims 10 and 21, Hatanaka et al teaches all of the above except the image recording apparatus, wherein said control part causes the image signal to be automatically recorded into a file, which a user cannot access, of the recording medium

However, Yoshida et al teaches the image recording apparatus, wherein said control part causes the image signal to be automatically recorded into a file (page 36, 0837, automatically starts the recording operation) which a user cannot access, (page 19, para 0485, the system FAT 42 is a system region that the user cannot access and is a region such as for file management information where the control means 14 utilizes in order to control the system) of the recording medium

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate control part of the image recording apparatus causing the image signal to be automatically recorded into a file which a user cannot access, of the recording medium as taught by Yoshida et al in the system of Hatanaka et al in order to

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cut back user intervention to record automatically and prevent unauthorized copying by preventing user access to restricted files.

Regarding claims 11 and 22, Hatanaka et al teaches all of the above except the image recording apparatus, wherein control information concerning the image signal is divided and recorded into the recording medium in a directory area thereof and also an area thereof in which the image signal is stored separately

However, Yoshida et al teaches the image recording apparatus as claimed in claim 8, wherein control information concerning the image signal is divided and recorded into the recording medium in a directory area thereof and also an area thereof in which the image signal is stored separately (page 20, para 0493, whenever the recording of the AV data in a new recording unit is completed, the control means 14 produces or updates the file management information that indicates in which recording unit the AV data is recorded. Then, this file management information is stored in its own memory)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the image recording apparatus as claimed in claim 8, wherein control information concerning the image signal is divided and recorded into the recording medium in a directory area thereof and also an area thereof in which the image signal is stored separately as taught by Yoshida et al in the system of Hatanaka et al in order to provide improved control of the file in case accidental erase of data occurs. In this case the control file is still accessible to reproduce data.

Allowable Subject Matter

6. Claims 5 – 7 and 16 – 18 are objected as being dependent on a rejected base claim, but would allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and amended to overcome the rejection(s) under 35 U.S.C. 102 set forth in this Office action.

Regarding claims 5 and 16, the prior art of record fails to teach, disclose or fairly suggest as recited in claim 5, the prior art fails to disclose the image recording apparatus, wherein:

the predetermined parameter includes a remaining storage capacity A (bytes) of said recording medium;

a time T (seconds) of recording reserved;

a maximum available recording bit rate Rmax (bps); and

a minimum available recording bit rate Rmin (bps); and

said control part determines the bit rate R (bps) by which the recording is performed such as that satisfying the following formula: $T \times R = A$ wherein, $R = R_{max}$ when $R > R_{max}$; and $R = R_{min}$ when $R < R_{min}$.

Regarding claims 6 and 17, the prior art of record fails to teach, disclose or fairly suggest as recited in claim 6, the prior art fails to disclose the image recording apparatus, wherein:

the predetermined parameter includes a remaining storage capacity A (bytes) of said recording medium; and

said control part lowers the bit rate by which the recording is performed when the

remaining storage capacity A is less than a predetermined value.

Regarding claims 7 and 18, the prior art of record fails to teach, disclose or fairly suggest as recited in claim 7, the prior art fails to disclose the image recording apparatus, wherein:

the predetermined parameter includes a remaining storage capacity A (bytes) of said recording medium;

a time T (seconds) of recording reserved; and

a minimum available recording bit rate Rmin (bps); and

said control part determines the bit rate R (bps) by which the recording is performed such as that satisfying the following formula: $T \times R = A$ wherein $R = R_{min}$ when $R < R_{min}$.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Shimoda et al (US 5289190) discloses a recording/reproducing apparatus including control signal indicating high-efficiency coding.

Maturi (US 5694332) discloses a MPEG audio decoding system with subframe input buffering.

Ikeda (US 6240244) discloses a disk apparatus having a single recording head and capable of simultaneous recording and reproducing.

Morioka et al (US 6226443) discloses a recording and reproducing apparatus.

Mitsuno (US 6219311) discloses a disc recording method and device, and disc like recording medium.

Cheung et al (US 6538656) discloses a video and graphics system with a data transport processor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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06/18/2007

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